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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/694,184	10/28/2003	Kazuyuki Matsumura	0171-1031P	3901
2292	7590	04/26/2004	EXAMINER	
BIRCH STEWART KOLASCH & BIRCH PO BOX 747 FALLS CHURCH, VA 22040-0747			MOORE, MARGARET G	
			ART UNIT	PAPER NUMBER
			1712	

DATE MAILED: 04/26/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/694,184	Applicant(s) MATSUMURA ET AL.	
	Examiner Margaret G. Moore	Art Unit 1712	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 to 9 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1 to 9 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____ | 6) <input type="checkbox"/> Other: ____ |

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1. Claims 1 to 9 are objected to because of the following informalities: It is technically incorrect to state that the copolymer comprises vinyl monomers, since the vinyl monomers must polymerize to form the copolymer and as such are not actually present. Appropriate correction is required.

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1 and 6 to 9 are rejected under 35 U.S.C. 102(b) as being anticipated by Funaki et al.

Funaki et al. teach a coating composition. Particular attention is drawn to Example 2, which contains each of (I), (II) and (III) in the required amounts. This coating composition is applied to a polycarbonate, and further coated with a silane/silica coating. This anticipates each limitation of claims 1 and 6 to 9.

4. Claims 1 to 3 are rejected under 35 U.S.C. 102(b) as being anticipated by WO 98/34991.

WO 98/34991 teaches a coating composition. lines 23 to 28 on page 11 shows monomers corresponding to (I), (II) and the photo-stabilizer of claims 2 and 3. Table 1 on page 12 shows copolymers prepared with these monomers, as well as a monomer (III). Examples 4 and 5 anticipate claims 1 to 3.

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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6. Claims 2 and 3 are rejected under 35 U.S.C. 103(a) as being unpatentable over Funaki et al. in view of WO 98/34991.

Funaki et al. fail to teach the presence of a light stabilizer having at least one cyclic hindered amine structure.

Page 3 in WO 98/34991, lines 5 to 25, teaches the benefits of including such a compound in an acrylic resin used as a coating. Generally, the coating will exhibit improved weatherability.

Thus one having ordinary skill in the art would have been motivated by the teachings of WO 98/34991 to incorporate a photo-stabilizer into the acrylic copolymer of Funaki et al. in an effort to improve the weatherability properties thereof, specifically by providing light stabilizing properties. In this manner, the instant claims are rendered obvious by this combination of references.

7. Claims 4 and 5 are rejected under 35 U.S.C. 103(a) as being unpatentable over WO 98/34991 or Funaki et al. in view of 4,043,953.

The teachings of WO 98/34991 and Funaki et al. have been detailed supra. Neither reference teaches the presence of a nitrogen containing silane in the coating compositions therein.

4,043,953 teaches an alkoxysilyl containing acrylic polymer used as a coating composition. In this composition, aminosilanes meeting the requirement of claims 4 and 5 are added as a means of improving the potlife of the composition. The table on the bottom of columns 3 and 4 show aminosilanes.

As such, one having ordinary skill in the art would have been motivated by the teachings in 4,043,953 to add an aminosilane meeting the requirements of claims 4 and 5 to the alkoxysilyl containing acrylic polymers in WO 98/34991 or Funaki et al. in an effort to improve the potlife thereof. In this manner these claims are rendered obvious.

8. Ide et al. is cited as being of general interest. This reference is the US equivalent of WO 98/34991, but only qualifies as prior art under 35 USC 102(e). Noda et al. teaches and/or renders obvious at least some of the claims, but this reference would not have

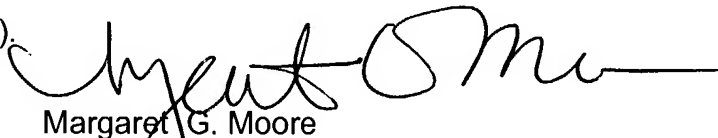
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qualified as prior art in the event that applicants filed a certified English translation of their priority document. Since this reference is not closer to the claims than those cited supra, the Examiner opted to not place this unnecessary burden on applicants. Valet et al. teaches a light stabilized binder that anticipates claim 1 but since claim 1 has already been rejected as being anticipated, a rejection has not been made to avoid redundancy.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Margaret G. Moore whose telephone number is 571-272-1090. The examiner can normally be reached on Monday to Wednesday and Friday, 10am to 4pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan can be reached on (571) 272-1119. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Margaret G. Moore
Primary Examiner
Art Unit 1712

mgm
4/21/04